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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/585,048
Filing Date: June 29, 2006
Appellant(s): BERGNER, JOAO JORGE

Michael J. Striker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/07/2009 appealing from the Office action mailed 05/08/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments

The appellant's statement of the status of amendments contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

GB 2397704 A	Mather et al.	07-2004
US 6,066,938	Hyodo et al.	05-2000
US 2002/0008044 A1	Burrus, IV	01-2002
US 2003/0150756 A1	Kajiya	08-2003
US 6,682,361 B2	Zweigle	01-2004

(9) Grounds of Rejection

The following is the Non-Final Action mailed on 05/08/2009

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is cancelled.

Claims 1, 2, 6, 7, 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over MATHER et al. (GB 2397704 A) in view of HYODO et al. (US 6,066,938).

As per claim 1, MATHER discloses a device with a power tool case (See Fig.1) that includes at least one receiving area for a power tool (See Fig.1, Item#1, discloses a case and Description, Par.4 discloses the case is for the storage of the power tool) and a charger (See Fig.1 Item#3, ports, and Description Par.7 discloses the charging ports are power by battery chargers of known types), wherein the charger and the power tool case are designed to remain connected during a charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger). Wherein said power tool is stored in a transport position in said first receiving area (See Description, Fig.1, and Description, Par.3, discloses a receiving area to store the power tool), but does not disclose said power tool is arranged in a second receiving area during said charging procedure in a standing position, and wherein said second area is embodied as a stand and comprises charging contacts to transmit charging energy.

HYODO discloses a power tool charger wherein the power tool is arranged in a receiving area during said charging procedure in a standing position and embodied as a stand and comprises charging contacts to transmit charging energy (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a standing position during charging and Fig4, Item#46a, discloses charging contacts that come into contact with the power tool battery terminals for charging).

MATHER and HYODO are analogous art since they both deal with power tools.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by MATHER with that of HYODO such that said power tool is arranged in a second receiving area during said charging procedure in a standing position for the benefit of allowing for the easy removal of the power tool from the charger using one hand while being charged and also would allow for charging of the power tool without having to disconnect the batteries and safely storing the power tool during transportation (See HYODO Col.1, lines 20-45).

As per claim 2, MATHER in view of HYODO disclose the device as recited in Claim 1 recited above, wherein the power tool case includes installation space (See Fig.1, Item#2, charging panel) for the charger (See Fig.1 Item# 3), and the charger is designed to remain in the installation space of the power tool case during the charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger).

As per claim 6, MATHER in view of HYODO disclose the device as recited in Claim 1 above, wherein the charger includes a wind-up device for a power cord (See MATHER, Fig.1, Item#5, retractable flex, and description, par.4 discloses the flex cord for the charger is housed inside the structure of the case with a pullout and lock and press button retraction system).

As per claims 7, MATHER in view of HYODO disclose a charger for a device as recited in claim 1 (See MATHER, Fig.1, Item#2, discloses charging panel).

As per **claim 11**, MATHER in view of HYODO disclose a power tool case for a device as recited in claim 1 (See MATHER Fig.1, Item#1, discloses a power tool case).

As per **claim 20**, MATHER in view of HYODO disclose the device as recited in claim 6, wherein said wind-up device comprises a rotatably supported storage means located underneath a receiving area of the charger (See MATHER Fig.1, Item#5 and 2, discloses a retractable flex cord housed underneath the receiving area of the charger).

Claims **1, 3, 4, 5 and 7-10, 12, 14-15 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over BURRUS, IV et al. (US 6,571,949) in view of HYODO (US 6,066,938).

As per **claim 1** BURRUS discloses a device with a power tool case (See Fig.2, Item#100, case) that includes at least one receiving area (See Fig.2, Item#101, power tool receiving area) for a power tool (See Fig.1, Item#104) and a charger (See Fig.1, Items# 101,102,103; 3 charging compartments, and Par.19, discloses the compartments include charging circuitry), wherein the charger and the power tool case are designed to remain connected during a charging procedure (See. Par.19 and 20; discloses the electrical connector in the power tool case delivers electrical power to the charging circuitry within the compartment 101 in Fig.2), wherein said power tool is stored in a transport position in said first receiving area (See Fig.2, Item#101 and 104, discloses a power tool and a receiving area for receiving the power tool), but does not disclose said power tool is arranged in a second receiving area during said charging procedure in a standing position.

HYODO discloses a power tool charger wherein the power tool is arranged in a receiving area during said charging procedure in a standing position (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a standing position during charging).

BURRUS and HYODO are analogous art since they both deal with power tools charging.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by BURRUS with that of HYODO such that said power tool is arranged in a second receiving area during said charging procedure in a standing position for the benefit of allowing for the easy removal of the power tool from the charger using one hand while being charged while maintaining secure charging for the power tool during transportation (See HYODO Col.1, lines 20-45).

As per **claim 3**, BURRUS in view of HYODO disclose the device as recited in claim 1 above, wherein the connection (See Fig.2, Item#105, electrical connector) between the charger (See BURRUS, Fig.2, Item# 101,102,103, charging compartments) and the power tool case (See Fig.2, Item# 100) is designed to be detachable (See BURRUS, Par.23, discloses the compartments (chargers) can be fixed or removable, Par.19 discloses the compartments include charging circuitry).

As per **claim 4**, BURRUS in view of HYODO disclose the device as recited in Claim 3 as discussed above, wherein the charger (See Fig.1, Item# 101,102,103) is connected with the power tool case (See BURRUS Fig.1, Item# 100) via at least one detachable fastening means

(See BURRUS, Fig.1, Item#105, connector, and Par.23, discloses that the compartments (chargers) can be fixed or removable).

As Per **claim 5**, BURRUS in view of HYODO disclose the device as recited in Claim 4 as discussed above, wherein the fastening means (See BURRUS, Fig.2, Item#105) is designed to be actuated without the use of tools (See BURRUS, Fig.2, Electrical connectors 105 snap on and off to electrical connectors within compartments 101, 102 and 103). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 7**, BURRUS in view of HYODO disclose a charger for a device as recited in claim 1 above (See BURRUS, Fig.1, Items# 101,102,103, and Par.19 discloses compartments include charging circuitry).

As per **claim 8**, BURRUS in view of HYODO disclose discloses the charger as recited in Claim 7 as discussed above, characterized by the fact that it is designed as a stand for the power tool (See HYODO, Fig.10, Items#1 and 20, discloses a charger used as a stand for the power tool).

As per **claim 9**, BURRUS in view of HYODO disclose the charger in claim 8 as recited above, in which the power tool (See Fig.10, Item#1) is positioned at least substantially in the machining direction (See HYODO, Fig.10, Items# 1 and 20, power tool placed on the charger in the machining position).

As per **claim 10**, BURRUS in view of HYODO disclose the charger as recited in Claim 8 above characterized by a coupling unit (See Fig.5, Item#43, positive and negative terminals on the power tool handle) that is designed to correspond with a coupling unit of a power tool unit (See Fig.2, Item#10, positive and negative electrodes on the charger) while the stand function is being performed and to at least transmit charging energy (See Col.1, lines 61-67, and Col.2, lines 1-11, disclose the electrical connection established between the first set of terminals on the power tool handle and the second set of terminals on the charger when the power tool is placed on the charger).

As per **claim 12**, BURRUS in view of HYODO disclose the device as recited in claim 1 as discussed above, wherein said power tool is stored in the transport position in said first receiving area in a lying position (See BURRUS, et al. Fig.2, Items#101 and 104, discloses a power tool laced in a lying position while being transported).

As per **claim 14**, BURRUS in view of HYODO disclose the device as recited in claim 1 as discussed above, wherein said power tool projects above a half of said power tool case when said power tool is arranged in the second receiving area (See HYODO Fig.10, discloses power tool projects above a half of said power tool case when said power tool is arranged in the charging area).

As per **claim 15**, BURRUS in view of HYODO disclose the device as recited in claim 14 as discussed above, wherein said power tool case is reliably prevented from being closed during said charging procedure due to the standing position of said power tool (See HYODO Fig.10, discloses the power tool projects above a half of said power tool case when said power tool is arranged in the charging area, as a result when the case will be kept open when the power tool is kept is placed in the charging position).

Claim **16** is rejected under 35 U.S.C. 103(a) as being unpatentable over BURRUS, IV et al. (US 6,571,949) in view of HYODO (US 6,066,938) and in further view of KAJIYA (US 2003/0150756A1).

As per **claim 16**, BURRUS in view of HYODO disclose the device as recited in claim 3 as discussed above, wherein a connecting means for the connection between the charger and the power tool case is integrally mounted to said power tool case (See BURRUS Fig.2, Item#105) but does not disclose the connection between the charger and the power tool case is embodied as a flexible flap.

KAJIYA discloses an electronic device case using a flexible flap as a connecting means between the case and the electronic device (See Par.4 and 5)

BURRUS, HYODO and KAJIYA are analogous art since they all deal with electronic devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by BURRUS in view of HYODO such that the connection

between the charger and the power tool case is embodied as a flexible flap for the benefit of allowing the charger to be swung out of the case for maintenance without having to be disconnected from the case.

As per **claim 19**, BURRUS in view of HYODO disclose the device as recited in claim 4 as discussed above, wherein said fastening means extends through a recess in a housing wall of said power tool case (See BURRUS, Fig.3, Item#105)

Claims **17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over BURRUS, IV et al. (US 6,571,949) in view of HYODO (US 6,066,938) and in further view of ZWEIGLE (US 6,682,361 B2)

As per **claims 17 and 18**, BURRUS in view of HYODO disclose the device as recited in claim 4 as discussed above, but does not disclose said fastening means is embodied as a detent element such as a latching hook.

ZWEIGLE discloses a locking mechanism comprising a detent hook (See COL.1, lines 20-23 and 63-67)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by BURRUS in view of HYODO with that of ZWEIGLE such that the fastening means is latching hook for the benefit of providing a secure releasable connection of the charger to the case (See ZWEIGLE, Col.1, lines 20-23 and 63-67, discloses a detent hook used to safeguard an electrical connection between plug parts so that it is not inadvertently released).

(10) Response to Argument

The following is in response to the VII. ARGUMENT section of the appeal brief

I. Rejection of Claims 1, 2, 6, 7, 11 and 20 as unpatentable over Mather et al. in view of Hyodo et al.

Appellant's first argument appears on page 5 of the appeal, and states that "Neither Mather nor Hyodo et al. discloses or teaches a device with a power tool case with a first receiving area and a second receiving area, wherein the power tool is stored in a transport position in the first receiving area and wherein the power tool is arranged in a second receiving area during a charging procedure in a standing position as defined in claim 1."

Appellant acknowledges on page 6 that "Mather discloses providing a case (1) with one storage area for a power tool case in the event of transportation and storage, respectively" and that "Hyodo et al. teaches arranging an impact screw driver in an upright position in a charger". The examiner agrees that the first receiving area is disclosed by Mather et al. and that a second receiving area is disclosed by Hyodo et al, the point of contention is whether the combination of Mather et al. and Hyodo et al. would lead to the modification of Mather et al. to add a second receiving area or to just replace the first receiving area disclosed by Mather et al. with that disclosed by Hyodo et al. such that the combination would yield a power tool case with one receiving area.

Appellant argues that "Hyodo et al. would only lead the practitioner to modify Mather et al. to provide one receiving area in which the tool could be charged in standing

position rather than stored in a lying position, since likewise, neither Mather nor Hyodo proposes two receiving areas.”

The examiner first argues that the appellant has not claimed separate and distinct receiving areas or that the transport position is not in fact the standing position. The examiner argues that even if the appellant’s argument that the combination would yield to one receiving area is held to be true, that the tool will be stored and charged in the standing position in that one receiving area and since the claim does not explicitly call for separate and distinct receiving areas or distinguishes the transport position from the charging “standing” position; the claim limitations are met.

However the examiner explains that the combination of Mather et al. and Hyodo et al. would still meets the limitations of the claimed invention even if the Board believes that such a requirement for separate and distinct receiving areas and that the transport position is different from the charging “standing” position. Mather et al. discloses a power tool case that includes a first receiving area for a power tool and a charger and the power tool is stored in a transport position in the first receiving area (See Mather et al., Fig.1, Items#1 and 2 and Description page 1, lines 11-21, disclose a power tool case comprising a receiving area for storing the battery and a charger for charging the batteries), Mather et al. further explains that the objective of the invention is “to combine the process of storage with that of charging.”

Hyodo et al. on the other hand discloses a charger with a second receiving area such that during charging the tool is placed in the standing position and the tool is charged via charging contacts (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a

standing position during charging and Fig4, Item#46a, discloses charging contacts that come into contact with the power tool battery terminals for charging).

The examiner explains that the appellant's argument that **"Hyodo et al. would only lead the practitioner to modify Mather et al. to provide one receiving area in which the tool could be charged in standing position rather than stored in a lying position, since likewise, neither Mather nor Hyodo proposes two receiving areas"** is incorrect because Mather et al. explicitly discloses that his main goal of the invention is to combine storage and charging, therefore eliminating the receiving area disclosed by Mather et al. and replacing it with the receiving area disclosed by Hyodo et al. as suggested by the appellant will only destroy the Mather et al. reference as it will provide a power tool case only for charging the power tool and not for charging and storing the power tool. The examiner further explains that all the elements were known in the prior art and that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by Mather et al. with that of Hyodo et al. with known methods by adding the charger disclosed by Hyodo et al. to the power tool case disclosed by Mather et al. for the benefit of providing a power tool case that combines storage of the power tool, charging of the batteries and also charging of the battery installed in the power tool without having to disconnect the battery from the power tool.

II. Rejection of Claims 1, 3, 4, 5, 7-10, 12, 14-15 and 19 As Unpatentable Over Burrus, IV in view of Hyodo et al.

The appellant repeats the same arguments on page 7, that **"Mather et al. does not disclose or teach a device with a power tool case with a first receiving area and a second**

receiving area, wherein the power tool is stored in a transport position in the first receiving area and wherein the power tool is arranged in the second receiving area during charging in a standing position as defined in claim 1." The grounds of rejection in question here are Burrus, IV in view of Hyodo et al., therefore these arguments regarding Mather et al. will not be addressed in this section as they have been previously addressed under arguments to rejection made under Mather et al. in view of Hyodo et al.

The appellant further argues on page 7, that in Burrus, IV **"no suggestion is provided which would have led someone skilled in the art to arrange the power tool in a standing position during charging or to provide a second receiving area for charging the power tool in a standing position. since the Burrus et al. reference specifically discloses arranging the power tool in a lying position during charging it could be seen why a person skilled in the art should change this arrangement"** and that such a modification **"contradicts the Burrus discloses, because charging of the power tool is performed during the transport and thus when the vehicle is moving"** and that **"a standing arrangement of the power tool would be very unstable and would lead to unreliable transport and charging of the power tool."**

The examiner explains that Burrus, IV discloses a power tool case installed on the back of a vehicle having a receiving area for storing and charging power tools during transportation i.e. while the vehicle is in motion (See Fig.2, Items#101 and 104, discloses a receiving area and a power tool to be stored and charged while in the receiving area).

Hyodo et al. on the other hand discloses a charger with a second receiving area such that during charging the tool is placed in the standing position and the tool is charged via charging contacts (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a

standing position during charging and Fig4, Item#46a, discloses charging contacts that come into contact with the power tool battery terminals for charging).

The examiner explains that the applicant's argument that there is no reason to modify Burrus, IV with Hyodo et al. to add a second receiving area for holding the battery in a standing position while charging and that such modification would contradict Burrus, IV since charging is done in the transport position is incorrect. It is true that Burrus, IV discloses placing the power tool in a lying position during transport and that power tool is charged in the transport position. However the examiner explains that modifying the Burrus, IV reference with the Hyodo reference by adding the second receiving area such that the power tool is placed in the standing position for charging while the vehicle is not in motion will provide a benefit for the user since it is clear that the Hyodo et al. charger provides much easier access to the power tool handle for removal and placement and it would be more convenient for the user to place a frequently used power tool in the second receiving area while the vehicle is not in motion, such that the user can quickly place and remove the power tool on and off the charger, and also such modification would also provide an indication to other users that a certain tool is currently being used and that it should not be removed from the power tool case.

The examiner further explains that modifying the Burrus, IV reference with the Hyodo et al. reference would not lead one of ordinary skilled in the art to replace the receiving area disclosed by Burrus, IV with that of Hyodo et al, but rather to add the second receiving area disclosed by Hyodo et al. to the power tool case disclosed by Burrus, IV. The appellant recognizes and agrees that replacing the first transport and charging receiving area disclosed by Burrus, IV with the charging area disclosed by Hyodo et al. **"would be very unstable and**

would lead to an unreliable transport and charging of the power tool" and that it "could also result in a damage of the power tool when falling out of the charger during transport." The examiner agrees with the appellant's assertion and explains that because of such reasoning a person skilled in the art would not modify the Burrus,IV reference by replacing its disclosed first receiving area with the Hyodo et al. disclosed second receiving area, but would rather lead to adding the second receiving area to the power tool case such that it has a first receiving area used for transporting and charging the power tool during transport and a second receiving area used to identify "label" currently used power tools and provide easy access to them during placement and removal on and off the charger second receiving area.

III. Rejection of Claim 16 As Unpatentable Over Burrus,IV in view of Hyodo et al. and in further view of Kajiva

Appellant argues on page 9, that because claim 16 depends from independent claim 1, therefore claims 16 is patentable for the same reasons as set forth above with regard to claim 1. As shown previously, Burrus,IV in view of Hyodo et al. teaches all the features of independent claim 1.

IV. Rejection of Claims 17 and 18 As Unpatentable Over Burrus,IV in view of Hyodo et al. and in further view of Zweigle

Appellant argues on page 9, that because claims 17 and 18 depend from independent claim 1, therefore claims 16 is patentable for the same reasons as set forth above with regard to claim 1. As shown previously, Burrus,IV in view of Hyodo et al. teaches all the features of

independent claim 1. As shown previously, Burrus, IV in view of Hyodo et al. teaches all the features of independent claim 1.

Final point of Note: the remaining references by Kajiya [US 2003/0150756 A1] and Zweigle [US 6,682,361] used in the current Non-Final Action disclose "using a flexible flap as connecting means between the case and the electronic device" (See Kajiya, Pars.4 and 5) and a "locking mechanism comprising a detent hook" (See Zweigle, Col.1, lines 20-23 and 63-67).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully Submitted,

/Ahmed H. Omar/

Examiner, Art Unit 2858

/Patrick J Assouad/

Supervisory Patent Examiner, Art Unit 2858

Conferees:

/Brian Sircus/
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